



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,183	11/29/2001	Todd Kueny	011450	1028

23464 7590 05/18/2005

BUCHANAN INGERSOLL, P.C.
ONE OXFORD CENTRE, 301 GRANT STREET
20TH FLOOR
PITTSBURGH, PA 15219

EXAMINER

CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
----------	--------------

2179

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/683,183	Applicant(s) KUENY, TODD	
	Examiner Joshua D Campbell	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Request for reconsideration accompanied by a Declaration filed on 12/17/2004.
2. Claims 1-19 are pending in this case. Claims 1 and 6 are independent claims.

Affidavit Under 37 CFR 1.132

3. The declaration under 37 CFR 1.132 filed 12/17/2004 is insufficient to overcome the rejection of claims 1-19 based upon Aizikowitz et al. in view of Think121.com under 35 U.S.C. 103(a) as set forth in the last Office action because:

A rule 132 affidavit/declaration can be used to prove that the subject matter relied on in the cited patent, publication, or activity was derived from and invented by the applicant and thus could not have been made "before the invention thereof by the applicant" under 35 U.S.C. 102(a). The declaration submitted by the applicant never clearly states that the applicant is the ***sole inventor*** of the cited portions of the reference in question (Think 121.com). The declaration merely states that the applicant is the president of the company that published the document and is the author of the cited reference. In order to overcome the rejection under 35 U.S.C. 103(a), which is based on the prior art (Think121.com) meeting the requirements of 35 U.S.C. 102(a), the declaration must contain a clear and concise statement that the applicant is the sole inventor of the portions cited in the rejection of claims 1-19. Thus, at this point the declaration is not sufficient to overcome the current rejection of claims under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Aizikowitz et al. (hereinafter Aizikowitz, US Patent Application Publication Number 2002/0049702, US filing date of February 3, 2000) in view of Think121.com (hereinafter think121, www.think121.com, published in October of 2000).

Regarding independent claim 1, Aizikowitz discloses a method in which a description of a composite page is parsed and stored (Pages 1-2, paragraphs 0011-0037 of Aizikowitz). Then, opening one or more input files base that identify unique resources based on the description and that file (Pages 1-2, paragraphs 0011-0037 of Aizikowitz). Aizikowitz also discloses that the resources are then copied to an output file, each unique resource is copied to said output file only once (Pages 1-2, paragraphs 0011-0037 of Aizikowitz). Aizikowitz does not disclose a method in which a composite graphic page is created from the resources which is then copied to the output file. However, think121 discloses a method in which a composite graphic page is created from resources which is then stored in an output file (Pages 2-3 of think121). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Aizikowitz and think121 because it would have

provided a way to quickly create and personalize documents to be view by large audiences.

Regarding dependent claims 2 and 3, Aizikowitz discloses a method in which the description is in a compositing language, ASCII text (Page 3, paragraphs 0051-0055 of Aizikowitz).

Regarding dependent claims 4 and 5, Aizikowitz discloses a method in which unused resources are copied to the output file (Pages 1-2, paragraphs 0011-0037 of Aizikowitz). Aizikowitz also discloses that the description of the file is also copied to the output file (Pages 1-2, paragraphs 0011-0037 of Aizikowitz).

Regarding independent claim 6, Aizikowitz discloses a method in which a description of a composite page is parsed and stored (Pages 1-2, paragraphs 0011-0037 of Aizikowitz). Then, opening one or more input files base that identify unique resources based on the description and that file (Pages 1-2, paragraphs 0011-0037 of Aizikowitz). Aizikowitz also discloses that the resources are then copied to an output file, each unique resource is copied to said output file only once (Pages 1-2, paragraphs 0011-0037 of Aizikowitz). Aizikowitz does not disclose a method in which a composite graphic page is created from the resources which is then copied to the output file, Aizikowitz also does not disclose that the method is performed using PDF input files, COS objects and PDF content streams. However, think121 discloses a method in which a composite graphic page is created from resources which is then stored in an output file (Pages 2-3 of think121). Think121 also discloses that customizations can be performed using input PDF files, COS objects, based on PDF content streams (Pages

Art Unit: 2179

2-3 and 29-37 of think121). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Aizikowitz and think121 because it would have provided a way to quickly create and personalize documents to be view by large audiences.

Regarding dependent claims 7-10, the claims incorporate substantially similar subject matter as claims 2-5. Thus, the claims are rejected along the same rationale as claims 2-5.

Regarding dependent claims 11-13, Aizikowitz does not disclose a method in which COS objects are assigned unique identifiers, that a PDF content stream is assembled as a COS array-type object, or that the arrays reference the COS objects using the unique identifiers. However, think121 discloses a method in which COS objects receive unique identifiers that are reference by a content stream using a COS array-type object (Page 29-37 of think121). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Aizikowitz and think121 because it would have provided a way to quickly create and personalize documents to be view by large audiences.

Regarding dependent claims 14-19, Aizikowitz does not disclose a method in which a composite graphic page consists of a base page and zero or more overlaid pages. However, think121 discloses a method in which a composite graphic page consists of a base page and zero or more overlaid pages (Page 29-37 of think121). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Aizikowitz and think121 because it would have

provided a way to quickly create and personalize documents to be view by large audiences.

Response to Arguments

6. Applicant's arguments filed 12/17/2004 have been fully considered but they are not persuasive.

The arguments presented are based on the declaration submitted by the applicant, which has been deemed insufficient to overcome the rejections. Thus, the arguments are rebutted for the same reasons given above referring to the insufficiency of the declaration.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC
May 12, 2005


HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100